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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/336,116	06/18/1999	CHUNG LAM	82225.P1423D	7276

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EXAMINER

AHMED, SHAMIM

ART UNIT

PAPER NUMBER

1746

DATE MAILED: 04/18/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

TD-6

Office Action Summary

Application No.

09/336,116

Applicant(s)

LAM, CHUNG

Examiner

Shamim Ahmed

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1746

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 9-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 9,13 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Wensink (5,443,675).

The rejection is repeated herein as the previous Office action mailed 09/20/01 (see paragraph 2 (first mentioned)).

Claim Rejections - 35 USC § 103

- 3 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wensink (5,443,675) in view of Winsemius et al (5,792,305).

The rejection is repeated herein as the previous Office action mailed 09/20/01 (see paragraph 2 (second mentioned)).

5. Claims 10,12 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wensink in view of Buck et al (5,489,854).

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The rejection is repeated herein as the previous Office action mailed 09/20/01 (see paragraph 3).

Response to Arguments

6. Applicant's arguments filed 1/25/02 have been fully considered but they are not persuasive. Applicant argues that Wensink does not teach decapsulation of an integrated circuit package that is mounted to a printed circuit board. This is not persuasive because Wensink teaches a process, wherein a plastic package is decapsulated from an integrated circuit that is mounted to a connector board with a plurality of pins. Wensink also teaches that the connector board is electrically connected to the integrated circuit with a plurality of leads (col.4, lines 7-20 and figure 1). The term "connector board" is conventionally used in the art; see Gomez (5,489,852) as evidence. Gomez teaches that connector board is a printed circuit board (col.3, line 1), which is a broad term of a printed circuit board. Therefore, the connector board is nothing but a printed circuit board. It is noted that Gomez is used only as an evidence to show the conventional meaning of the term. The use of this reference does not introduce any new ground of rejection because Wensink in contrast to applicant's arguments teaches the circuit board.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shamim Ahmed whose telephone number is (703) 305-1929. The examiner can normally be reached on M-Thu (7:00-5:30) Every Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (703) 308-4333. The fax phone

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numbers for the organization where this application or proceeding is assigned are (703)-305-7718 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

SA
April 16, 2002

Shamim Ahmed
Patent Examiner



ALEXANDER MARKOFF
PRIMARY EXAMINER